

REMARKS/ARGUMENTS

This paper is responsive to the Office Action mailed June 30, 2009. Claims 1, 2, 4, 5, 9-18, 20 and 24-31 were pending before submission of this paper. Claims 1, 2, 4, 5, 9-18, 20 and 24-31 stand rejected. Specifically, claims 1, 13 and 24 stand rejected under 35 U.S.C. § 112 as being indefinite. Claims 1, 2, 4, 5, 9-18, 20 and 24-31 24 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Calabria. Claims 1, 2, 4-5, 9, 13-16, and 25 have been amended. Support for all amended claims can be found in the specification, and no new matter has been added by these amendments. Reconsideration of the claims in view of the amendments and the following remarks is respectfully requested.

I. Claims 1, 13, And 24 Are Allowable Under 35 U.S.C. § 112, Second Paragraph

Claims 1, 13 and 24 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter of the claims.

Applicant has amended claims 1, 13, and 24 to address issues raised in the Office Action with respect to 35 U.S.C. § 112, Second Paragraph. Beginning with claim 1, the amended claim recites:

A computer-implemented method for determining when to place an advertisement for an item on a first page of search results for a search request related to the item, the method comprising:

under control of one or more computer systems configured with executable instructions,

receiving search data relating to previously-executed searches, the search data indicating:

search terms submitted by users;

placement of links to information for the item within corresponding sets of search results provided for display to users; and whether the users selected the link for the item from the search results;

determining, based at least in part on the received search data, an extent relating a search term to an item, the extent being a function of a frequency

of selection of a link to information for the item when the link is displayed and a page number on which the link was presented in a set of search results generated by execution of the search term, the extent being determined to be greater for a higher page number at the same frequency of selection; and

upon receiving a search request containing the search term, determining to place an advertisement for the item on the first page of the search results for the search request when the extent exceeds calculated extents relating the search term to other items for which links to information for said other items appear in the search results for the search request, independent of a page number of the search results on which the link for the item is configured to be displayed, wherein said search results are to be provided to a consumer computer system different than said one or more computer systems.

The Office Action on page 2 alleges that, because claim 1 recited “search result data,” “it is unclear if the search result is received for each previously-executed search i.e., each previously executed search provide the same result.” Thus, it appears the Office Action alleges confusion of the relationship of the term “search result data” with respect to subsequent instances of “search result” in the claim. Applicant has amended claim 1 to recite “search data” to clarify that the data is not limited to a single search result. Thus, Applicant respectfully submits that the issue of whether “the search result is received for each previously-executed search” is now moot.

Also at page 2, the Office Action alleges that, “it is also unclear if the ‘each’ stands for the search result or the previously executed searches.” Applicant has deleted “searches that each included a link to information for the item in a corresponding set of search results” from claim 1 and amended the subsequent description of the search data accordingly. Thus, Applicant respectfully submits that the issue raised in the Office Action regarding the term “each” has been addressed.

In addition, the Office Action on pages 2 and 3 alleges that it is also unclear whether “the previously-executed search includes a placement of the link within the corresponding set of search result” and to what “whether the user selected the link” refers. As noted above, Applicant has amended claim 1 to clarify the description of the “search data” with respect to remaining portions of the claim. In particular, claim 1 has been amended to delete reference to “the link” and “previously executed search” in the description of the “search data.”

With respect specifically to “whether the user selected the link,” Applicant submits that deletion of “the link” from the subsequent description of the “search data” addresses any issues as to clarity. Thus, Applicant respectfully submits that the aforementioned issues concerning placement of the link and whether the user selected the link has been addressed.

The Office Action at page 3 asks “If each of the search result data includes a link to information for the item, then which link is considered ‘the link’ since more than one link is included in the search result for each query.” Applicant respectfully submits that claim 1 did not recite that “each of the search result data includes a link.” Further, Applicant respectfully submits that the above-discussed amendment to remove reference to “the link” from the description of the “search [result] data” addresses this issue.

The Office Action at page 3 alleges that “it is also unclear what is meant by determining whether the user selected the link or not” and asks “Does it mean it is determined the likelihood the user selected one of the links or determining whether the user selected or not?” Applicant respectfully submits that the term “likelihood” was not and is not recited in claim 1 and, therefore, does not serve to limit the claim. In any event, “to which users who entered the search term subsequently selected the link to the item from the search results” has been deleted from claim 1. Accordingly, Applicant respectfully submits that any issue regarding the meaning of “whether the user selected the link or not” has been addressed.

On page 4, the Office Action alleges that “it is also unclear what applicant intended to claim by ‘upon receiving a subsequent search request containing the search term, determining to place an advertisement for the item on the first page of the search results for the search request when the extent to which users selected the link to the item exceeds calculated extents for other items in the search results for the subsequent search request, independent of a page number of the search results on which the link for the item is configured to be displayed.’ According to the Office Action, “It is unclear if the search result data for an item also includes other items in the search result” and “if the subsequent search request containing the search term refers to a follow-up search request using the same search term, (i.e., after an initial search using the same term is executed).” As amended, claim 1 recites “upon receiving a search request

containing the search term, determining to place an advertisement for the item on the first page of the search results for the search request when the extent exceeds calculated extents.” Claim 1 has also been amended to clarify that the “calculated extents relating the search term to other items for which links to information for said other items appear in the search results for the search request.” Applicant respectfully submits that this amendment clarifies the aforementioned issues raised in the Office Action.

In light of the above-discussed amendments to claim 1, Applicant respectfully submits that all issues raised under 35 U.S.C. § 112, Second Paragraph. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, Second Paragraph be withdrawn.

With respect to claim 13, the Office Action on page 4 alleges that “it is unclear what determining an extent to which users selected a link to an item presented in search results for previously-submitted queries including the search term and related to the item when the link was included on a page other than a first page of the search results, the extent being determined to be greater for a higher page number at a common frequency of selection.” The Office Action asks “Does ‘determining an extent to which’ means [sic] determining whether users selected the link or why the users selected the link or the number of times users selected the link?” Thus, it appears that the Office Action alleges that the term “extent” in the claims is unclear. Applicant has amended claim 13 to change the term “extent” to “score” and to further clarify that the score is “based at least in part on: a frequency at which users selected a link to an item presented in sets of search results for previously-submitted queries including the search term and related to the item when the link was included on a page other than a first page of each set of search results; and for each set of search results, a page number for the page, wherein the score is determined to be greater for a higher page number at a common frequency of selection.” In light of this amendment, Applicant respectfully submits that the issue raised in the Office Action with respect to claim 13 has been resolved. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, Second Paragraph of claim 13 be withdrawn.

With respect to claim 24, the Office Action at pages 4 and 5 rejects claim 24 because the claim allegedly “also recites similar limitation.” Applicant has amended claim 24 to

change the term “extent” to “score” and to further clarify that the score is “based at least in part on: a frequency at which users selected a link to an item presented in sets of search results for previously-submitted queries including the search term and related to the item when the link was included on a page other than a first page of each set of search results; and for each set of search results, a page number for the page, wherein the score is determined to be greater for a higher page number at a common frequency of selection.” In light of this amendment, Applicant respectfully submit that the issue raised in the Office Action with respect to claim 24 has been resolved. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, Second Paragraph of claim 13 be withdrawn.

With respect to claims 2, 4-5, 9-12, 14-18, 20, and 25-31, which depend on one of claims 1, 13, and 24, discussed above, the Office Action on page 5 alleges that “dependent claims are also rejected since they inherit the rejected limitation of the independent claims.” Applicant respectfully submits that, because any issues raised in the Office Action with respect to claims 1, 13, and 24 have been addressed by the amendments and remarks discussed above, the dependent claims 2, 4-5, 9-12, 14-18, 20, and 25-31 are now in condition for allowance. Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. § 112, Second Paragraph of claim 13 be withdrawn.

II. Claims 1, 2, 4, 5, 9-18, 20, and 24-31 Are Allowable Under 35 U.S.C. § 102 Over Calabria

Claims 1, 2, 4, 5, 9-18, 20, and 24-31 stand rejected under 35 U.S.C. § 102(e) as being anticipated by Calabria. Applicant respectfully disagrees.

“A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Applicant respectfully submits that Wolton does not disclose all elements of the pending claims.

A. Independent Claim 1

Applicant's claim 1 as amended recites a "computer-implemented method for determining when to place an advertisement for an item on a first page of search results for a search request related to the item," comprising:

under control of one or more computer systems configured with executable instructions,
receiving search data relating to previously-executed searches, the search data indicating:
search terms submitted by users;
placement of links to information for the item within corresponding sets of search results provided for display to users; and whether the users selected the link for the item from the search results;
determining, based at least in part on the received search result data, an extent relating a search term to an item, the extent being a function of a frequency of selection of a link to information for the item when the link is displayed and a page number on which the link was presented in a set of search results generated by execution of the search term, the extent being determined to be greater for a higher page number at the same frequency of selection; and
upon receiving a search request containing the search term, determining to place an advertisement for the item on the first page of the search results for the search request when the extent exceeds calculated extents relating the search term to other items for which links to information for said other items appear in the search results for the search request, independent of a page number of the search results on which the link for the item is configured to be displayed, wherein said search results are to be provided to a consumer computer system different than said one or more computer systems.

Such limitations are not disclosed, taught, or suggested by Calabria.

The Office Action at page 5 cites to paragraphs 6-17, 21-25, and 53-57 of Calabria for disclosure of every element of claim 1. Applicant respectfully disagrees that Calabria discloses every element of claim 1, especially in light of the aforementioned amendments.

Calabria discloses approaches for "automatically generating a plurality of bids for an advertiser for placement of at least one advertisement in association with a search results list" (paragraph [0021]). Candidate advertisements are received from an advertiser, and a list of

candidate keywords is associated with each candidate advertisement (paragraph [0021]). For each “advertisement-keyword pair”, a click-through-rate (CTR) is calculated, as well as a “return on advertising investment (ROAI)” and, ultimately, a “bid amount” (paragraphs [0021]-[0022]). This information can be used to select “appropriate keyword advertisements” for inclusion in a “keyword search results list” to be “communicated to the user” (paragraph [0039]). This is very different from what is recited in Applicant’s claim 1 as amended.

For example, amended claim 1 recites “receiving search data relating to previously-executed searches, the search data indicating: search terms submitted by users; placement of links to information for the item within corresponding sets of search results provided for display to users; and whether the users selected the link for the item from the search results.” Calabria does not disclose these elements.

The Office Action at page 7 alleges that the corresponding element of claim 1 prior to the present amendment is disclosed in Calabria because “Calabria teaches user the method is related to key-word advertising associated with or found within a regular search results list generated, for example, by Internet search engine in response to a keyword query submitted by a user.” The Office Action gives an example whereby “when a user searches for ‘deck plans’ using a search engine such as Google or AltaVista in addition to the usual query result, the user will be shown a number of sponsored results (see [0003]-[0010]).” Therefore, the Office Action alleges, “Calabria teaches search result data to a user search query (previously-executed searches) including link to information for the item queried (in Google or AltaVista the search results provide link to information for the query item for example “deck plans”, whether the user selects any of the links in the search results.” In other words, the Office Action asserts that Calabria teaches the aforementioned elements because the “search [result] data” is received by a consumer who submitted a search query.

Applicant has amended claim 1 to recite that the “computer-implemented method for determining when to place an advertisement for an item on a first page of search results for a search request related to the item” is performed “under control of one or more computer systems configured with executable instructions” where the search results are “provided to a consumer

computer system different than said one or more computer system.” As a result, Applicant respectfully submits that the consumer computer system in Calabria that receives the search results does not perform the element of “receiving search data relating to previously-executed searches, the search data indicating: search terms submitted by users; placement of links to information for the item within corresponding sets of search results provided for display to users; and whether the users selected the link for the item from the search results” because the “consumer computer system” that receives the search results is “different than said one or more computer system” that “receive[es] search data” as recited in claim 1. Consequently, for at least this reason, Applicant respectfully submits that Calabria does not disclose, teach, or suggest all elements of claim 1. Therefore, Applicant respectfully submits that claim 1 is allowable under 35 U.S.C. § 102 for at least this reason.

As another example, amended claim 1 recites “determining, based at least in part on the received search result data, an extent relating a search term to an item, the extent being a function of a frequency of selection of a link to information for the item when the link is displayed and a page number on which the link was presented in a set of search results generated by execution of the search term” where “the extent [is] determined to be greater for a higher page number at the same frequency of selection.” With respect to the corresponding element of claim 1 prior to the present amendment, the Office Action at page 8 in the Response to Arguments section appears to note that this element was disregarded in the Office Action because of the aforementioned issues under 35 U.S.C. § 112, Second Paragraph. Thus, the Office Action does not appear to allege that Calabria discloses this element. Applicant respectfully submits that Calabria does not disclose, teach, or suggest the above element, as that element is currently presented in amended claim 1. Consequently, Applicant respectfully submits that claim 1 is allowable under 35 U.S.C. § 102 for at least this additional reason.

B. Dependent Claims 2, 4, 5, 9-12

Claims 2, 4, 5, 9-12 depend from claim 1 and, therefore, Applicant respectfully submits that claims 2, 4, 5, 9-12 are allowable at least for depending from an allowable claim. It

is additionally submitted that at least some of claims 2, 4, 5, 9-12 independently recite patentable subject matter. For example, amended claim 2 recites that “the first page of the search results for the search request excludes any link to information for the item that is unassociated with the advertisement.” The Office Action at pages 5 and 6 asserts that this element is disclosed by Calabria at paragraphs 37, 59, 72, and 134. Applicant respectfully disagrees.

Paragraphs 37, for example, discusses a “keyword search engine 12” that “includes a keyword search query/result list process 26, a content selection logic process 28, a bid selection logic process 30, a keyword advertisement bid database 32, and a sponsored results (i.e., advertisement) database 34.” The keyword search engine of Calabria “may also include one or more of an other results (e.g., non-paid search results) database 36, an other content (e.g., news, information, entertainment, etc.) database 38, a data collection logic process 40, and an advertiser feedback (e.g., keywords used in previous search queries, advertisements displayed in previous search results lists, click-through information for previous search results lists, and descriptive information about consumers that submitted previous search queries, etc.) database 42.” Thus, paragraph 37 discusses only general components of a keyword search engine and does not disclose that “the first page of the search results for the search request excludes any link to information for the item that is unassociated with the advertisement.”

Paragraph 59 describes a “market maximization mechanism, which is a software logic system contained on the keyword advertisement management system 14 of a provider, can calculate the profit accruing to advertisers.” The rest of the paragraph defines various terms in connection with the market maximization mechanism, but does not describe that “market maximization mechanism, which is a software logic system contained on the keyword advertisement management system 14 of a provider, can calculate the profit accruing to advertisers,” as recited in claim 2. The only page described in the paragraph is “landpage” which “is an optional parameter that specifies the URL in which the user "lands" after the advertisement is clicked” and not the location of a link to information about a product, as recited in claim 2.

Paragraph 72, likewise, is directed to “many ways of calculating ClickthruRate and ROAI.” These include “good initial guesses” that include “language processing techniques,”

“passing (advertisement, keyword) data to the advertiser during the click event..., having the advertiser associate this data with revenue data and transmitting it to the provider” and others. None of the techniques in paragraph 72 discuss that “the first page of the search results for the search request excludes any link to information for the item that is unassociated with the advertisement.” As with paragraph 59, the only reference to a page in paragraph 72 is a “landpage.”

Paragraph 134 is directed to “the total return of a click-through (which may be based on a particular keyword and/or a particular advertisement, or an average for the web site regardless of keyword and advertisement combinations).” The remainder of the paragraph discusses the “deck plans” example discussed above in connection with claim 1. Thus, paragraph 34 likewise does not disclose, teach, or suggest that “the first page of the search results for the search request excludes any link to information for the item that is unassociated with the advertisement,” as recited in claim 2. Therefore, for at least this additional reason, Applicant respectfully submits that claim 2 is allowable under 35 U.S.C. § 102 over Calabria.

As another example, Claim 4 recites that the “search data” as recited in claim 1 “is generated by a search engine service”, while claim 5 recites that the “search data” is “received from a search engine service.” Claim 9 recites that the “search data is derived from information sources”, claim 10 recites that “the information sources include web pages”, and claim 11 recites that “the information sources include content not available through the Internet.” As discussed above, Applicant has amended claim 1 to distinguish over the Office Action’s allegation that Calabria discloses the “search data.” Consequently, the above claims which further define aspects of the “search data” are also not disclosed, taught, or suggested by *Calabria*, such that at least some of these claims are further patentable in their own right.

C. Independent Claim 13

Applicant respectfully submits that claim 13 is allowable at least for reasons similar to those discussed above in connection with claim 1. For example, claim 13 recites “in response to receiving a search query submitted from a consumer computer system different from

said one or more computer systems and including a search term, determining a score.” Claim 13 specifies that the score is “based at least in part on: a frequency at which users selected a link to an item presented in sets of search results for previously-submitted queries including the search term and related to the item when the link was included on a page other than a first page of each set of search results; and for each set of search results, a page number for the page, wherein the score is determined to be greater for a higher page number at a common frequency of selection.” For at least reasons similar to those set forth above, Calabria does not disclose, teach, or suggest these elements. Therefore, at least for reasons similar to those discussed above, Applicant respectfully submits that Calabria does not anticipate claim 13. Accordingly, Applicant respectfully submits that claim 13 is allowable under 35 U.S.C. § 102 over Calabria.

D. Dependent Claims 14-18 and 20

Claims 14-18 and 20 depend from claim 1 and, therefore, Applicant respectfully submits that claims 14-18 and 20 are allowable at least for depending from an allowable claim. It is additionally submitted that at least some of claims 14-18 and 20 independently recite patentable subject matter. For example, amended claim 14 recites that “a search engine service provides the link to be included with the search results without payment of an advertising fee from an advertiser.” The Office Action at page 6 alleges that “search engine service provides the link of a search result without payment of an advertisement fee (search results are provided to the user without the user paying advertisement fee).” Applicant has amended claim 14 to recite that the “advertising fee” is not paid “from an advertiser.” Therefore, Applicant respectfully submits that, in light of this distinguishing amendment, Calabria does not teach, suggest, or disclose such subject matter as recited in claim 14.

The Office Action on page 6 also alleges that the subject matter of claim 14 is “nonfunctional descriptive material” that “will not distinguish the claimed invention from the prior art in terms of patentability” because “there is no additional step performed.” The Office Action cites to *In re Gulack*, 703 F.2d 1381, 1385, 217 U.S.P.Q. 401, 404 (Fed. Cir. 1983) and *In re Lowry*, 32 F.3d 1579, 32 U.S.P.Q.2d 1031 (Fed. Cir. 1994). Applicant respectfully disagrees

that an additional step must be performed in order to distinguish the claimed invention from the prior art in terms of patentability. In particular, Applicant respectfully notes that claim 14 is directed to “the link” which appears in the element of claim 13 that includes “a frequency at which users selected a link to an item presented in sets of search results for previously submitted queries including the search term and related to the item when the link was included on a page other than a first page of each set of search results.” Therefore, features recited in connection with “the link” further define the “frequency” recited in claim 13 and, as a result, are functional.

E. Independent Claim 24

Applicant respectfully submits that claim 24 is allowable at least for reasons similar to those discussed above in connection with claim 1. For example, claim 24 recites “in response to receiving a search query submitted from a client device different from said computer system and including a search term, determining a score.” Claim 24 specifies that the score is “a frequency at which users selected a link to an item presented in sets of search results for previously-submitted queries including the search term and related to the item when the link was included on a page other than a first page of each set of search results” and “for each set of search results, a page number for the page on which the link was included.” Claim 24 also recites that “the score is determined to be greater for a higher page number at a common frequency of selection.” Therefore, at least for reasons similar to those discussed above, Applicant respectfully submits that Calabria does not anticipate claim 24. Accordingly, Applicant respectfully submits that claim 24 is allowable under 35 U.S.C. § 102 over Calabria.

F. Dependent Claims 25-31

Claims 25-31 depend from claim 1 and, therefore, Applicant respectfully submits that claims 25-31 are allowable at least for depending from an allowable claim. It is additionally submitted that at least some of claims 25-31 independently recite patentable subject matter. For example, amended claim 25 recites that “a search engine service provides the link of a search result without payment of an advertising fee from an advertiser.” At least for reasons similar to

those discussed above, Applicant respectfully submits that Calabria does not disclose, teach, or suggest this element. Therefore, Applicant respectfully submits that claim 25 is allowable under 35 U.S.C. § 102 over Calabria for at least this additional reason.

G. A *Prima Facie* Case of Anticipation Has Not Been Made

In addition to the foregoing, Applicant respectfully submits that a *prima facie* case of anticipation by Calabria has not been made by the Office Action.

To establish a *prima facie* case of anticipation of a claim, the Examiner is obligated to identify where “each and every facet of the claimed invention is disclosed in the applied reference.” *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1462 (Bd. Pat. Interf. 1990). The goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant have a fair opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity. *See* MPEP § 706. The following is a quote of the applicable section of the Code of Federal Regulations:

“In rejecting claims for want of novelty or for obviousness, the examiner must cite the best references at his or her command. When a reference is complex or shows or describes inventions other than that claimed by the applicant, the particular part relied on must be designated as nearly as practicable. The pertinence of each reference, if not apparent, must be clearly explained and each rejected claim specified.” 37 CFR § 1.104(c)(2) (emphasis supplied).

In the present application, the Office Action has failed to meet the burden of identifying relevant portions of Calabria that disclose all the limitations of every single claim. For example, in its rejection of claims 1, 4, 5 and 9-12 on page 5, the Office Action makes a general citation to twenty-two paragraphs for disclosure of every element of the claims. Claims 13 and 24 are similarly rejected on page 6. The Office Action does not clearly explain the pertinence of Calabria to each element of the claims and does not identify where “each and every facet of the claimed invention is disclosed” in Calabria, as required by MPEP § 706 and 37 CFR § 1.104(c)(2).

Accordingly, Applicant respectfully requests that, in accordance with MPEP § 706 and 37 CFR § 1.104(c)(2), should the foregoing amendments and remarks not result in issuance of a Notice of Allowance, any future Office Action particularly designate as nearly as practicable any element that is alleged to be disclosed, taught, suggested, or otherwise present in a cited reference. In addition, for elements that are not explicitly disclosed, taught, or suggested, Applicant respectfully requests explanation of the pertinence of cited references.

III. Amendment To The Claims

Unless otherwise specified or addressed in the remarks section, amendments to the claims are made for purposes of clarity, and are not intended to alter the scope of the claims or limit any equivalents thereof. The amendments are supported by the specification and do not add new matter. In addition, by focusing on specific claims and claim elements in the discussion above, Applicant does not imply that other claim elements are disclosed or suggested by the references. In addition, any characterizations of claims and/or cited art are being made to facilitate expeditious prosecution of this application. Applicant reserves the right to pursue at a later date any other broader or narrower claims that capture any subject matter supported by the present disclosure, including subject matter found to be specifically disclaimed herein or by another prosecution. Accordingly, reviewers of this or any child or related prosecution history shall not reasonably infer that Applicant has made any disclaimers or disavowals of any subject matter supported by the present disclosure.

Appl. No. 10/748,694
Amdt. dated August 26, 2009
Amendment under 37 CFR 1.116 Expedited Procedure
Examining Group 3622

PATENT

CONCLUSION

In view of the foregoing, Applicant believes all claims now pending in this Application are in condition for allowance and an action to that end is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 206-467-9600.

Respectfully submitted,

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